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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,580	12/20/2001	Brian R. Janes	01-659US	3268

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PATENT DEPT.  
PEORIA, IL 616296490

EXAMINER
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LOWE, MICHAEL S

ART UNIT	PAPER NUMBER
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3652

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/028,580

Applicant(s)

JANES ET AL.

Examiner

M. Scott Lowe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 36-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 28 recite the limitation "said load bearing member" in lines 2 and 3 respectively. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13-27, 29-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Walth et al (US 6,158,949).

Re claims 1, 17, Walth teaches a load bearing arrangement for use with a work machine of the type having a platform 80, comprising:  
at least one load bearing member 10 structured and arranged for coupling to the platform 80;  
said load bearing member 10 having an end comprising a material having a first yield strength;

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an aperture 70,54 formed in said end and having an aperture wall; at least one support member 56 contained within said aperture adjacent to at least a portion of said aperture wall, said support member having an opening sized to receive a bearing; and said support member 56 having a second yield strength greater than said first yield strength.

There is reason to believe, based on the similarity of (material, structure, etc.), that the functional limitation(s) of the second yield strength being greater than the first yield strength may be (an) inherent characteristic of work machine load bearing arrangements. In accordance with *In re Best*,

562 F.2d 1252, 195 USPQ 430, 433 (CCPA 1977):

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or of prima facie obviousness under 35 USC 103" (195 USPQ at 432).

Accordingly, the burden is placed upon the applicant to prove that the yield strength limitations in question are not (an) inherent characteristic (s) of work machine load bearing arrangements.

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Re claims 2, 18, Walth teaches the load bearing arrangement wherein said support member 56 comprises a substantially cylindrical structure having a through opening.

Re claims 3, 19, Walth teaches load bearing arrangement further comprising a bearing 56 received in said opening.

Re claims 4, 11, 20, 27, the added limitation of "laser welding" is rejected as adding no structure to the claims and is also an inherently taught characteristic of work machines.

Re claims 5, 21, Walth teaches load bearing arrangement wherein said member 10 comprises:

- at least one top plate 16;

- at least one bottom plate 18; and

- at least one pair of spaced apart side plates 20, 21 each attached to said top plate 16 and said bottom plate 18.

Re claims 6, 22, Walth teaches load bearing arrangement wherein said top plate comprises at least one integral mounting structure (not numbered but shown on figures 2-4).

Re claims 7, 23, Walth teaches a load bearing arrangement comprising a substantially cylindrical attachment structure 50, 56 extending from at least one said side wall; and wherein said side wall is attached to said attachment structure 50, 56.

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Re claims 8, 24, Walth teaches a load bearing arrangement wherein said member 10 has a transverse width; and said attachment structure 50, 56 spans said transverse width.

Re claims 9, 25, Walth teaches a load bearing arrangement further comprising at least one reinforcing structure 42 attached to at least one said side plate 20, 21.

Re claims 10, 26, Walth teaches a load bearing arrangement wherein said reinforcing structure comprises a base portion (not numbered); and a rib portion (not numbered) extending from said base portion.

Re claims 13, 14, 29, 30, 33, 34, Walth teaches a pivotally connected attachment bucket 82.

Re claim 15, Walth teaches a load bearing arrangement for use with a work machine of the type having a platform 80, comprising a plurality of pieces connectable to form a member 10 structured and arranged for pivotable attachment to the platform; a weldment (columns 3-4, etc.) connecting at least two of said pieces. The limitation "at least one said weldment being simulated for effects of heat on at least one of said pieces subject to said weldment" adds no structure and is thus not given any patentable weight.

Re claims 16, 35, the limitation is rejected as adding no further structure to the claims.

Re claim 31, Walth teaches a load bearing apparatus, comprising: a work machine having a platform 80; at first member 10, having a longitudinal axis, coupled to said platform 80; a first movement means (not numbered) for moving said first member

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10 relative to said platform; a second member 68, having a longitudinal axis, pivotally coupled to said first member 10; a second movement means (not numbered) for moving said second member 68 relative to said first member 10; a plurality of pieces connectable to form at least one of said first and second members; a weldment connecting at least two of said pieces. The limitation "at least one said weldment being simulated for effects of heat on at least one of said pieces subject to said weldment" adds no structure and is thus not given any patentable weight.

Re claim 32, Walth teaches first and said second movement means comprises hydraulic cylinders.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walth et al (US 6,158,949) in view of Ginn et al (US 6,409,459).

Re claims 12, 28, Walth is silent as to whether the side plates are single or multi-piece structures. Ginn teaches in figure 7 a multi-piece side plate with collinear centerlines at the point of connection for the adjacent side plates. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Walth by Ginn to have a multi-piece side plate with collinear centerlines at the



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point of connection for the adjacent side plates to allow for easier construction by use of smaller and thus easier to handle sections.

### ***Conclusion***

Applicant's arguments filed 9/5/03 have been fully considered but they are not persuasive.

Applicant argued on page 9 of amendment A that Walth does not meet the new limitations of claim 1. However, support member 10 does receive a bearing 56 (column 3, 2<sup>nd</sup> to last paragraph).

Applicant argued that laser welding (as well as the limitations of claims 15 & 31) is not inherently taught by Walth and is a basis for patentability. Nonetheless, laser welding (as well as the limitations of claims 15 & 31) is well known and there is reason to believe that the reference inherently teaches laser welding (as well as the limitations of claims 15 & 31) (see the "In re Best" reference above).

Applicant argued that Walth does not teach a reinforcing structure attached to at least one of the side plates. The stated claim language does not limit away from the reinforcing structure attaching to the side plates through attachment to another structure, which is attached to the side plates.

Applicant argued that he is unclear about the rejection of claims 10 and 26. The rejection is restated above and can be clearly seen in figure 2.



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Applicant argued that Walth and Ginn do not teach the limitations of claims 12 & 28. However, the combination does teach the limitations as discussed above in the rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Scott Lowe whose telephone number is 703-305-1940. The examiner can normally be reached on 6:30am-4:30pm M,Tu,Th,F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 703-308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

msl



EILEEN D. LILLIS  
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